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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,219	01/30/2004	Kin Yip Wan	08364.0073	2586
22852	7590	06/30/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			LEE, Y MY QUACH	
			ART UNIT	PAPER NUMBER.
			2875	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,219

Applicant(s)

WAN ET AL.

Examiner

Y Quach Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 67-69 is/are allowed.
- 6) ☒ Claim(s) 1,2,9,57,58,60-62 and 64-66 is/are rejected.
- 7) ☒ Claim(s) 3,7,10,56,59 and 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 7, 2005 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 58 to 66 are objected to because of the following informalities: In claim 58, there is no clear antecedent basis for "the controller". In claim 59, there is no clear antecedent basis for "the light transmissive wall portion". In claim 60, there is no clear antecedent basis for "the enclosure". In claims 64 and 65, the term "a light pattern" is improper and should be changed to --the light pattern--. Note "a light pattern" is first introduced in claim 58. Claims 61 to 63 and 66 depend on objected claim 58 and as such are also objected. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rapisarda.

Rapisarda shows an article of apparel (10) carrying an enclosed chamber (a hollow cavity, column 1, line 56), a light source comprising at least one light emitting diode (14) operable to illuminate the chamber with light, the chamber having a light affecting device (a faceted lens, column 2, line 30) adapted to affect light from the light source so as to produce a light pattern, the chamber having a light transmissive portion providing a window (opening of the chamber) through which light from the light source can be transmitted to enable the light pattern to be viewed, the article also carrying a controller having a sensor (17) operable to sense motion of the article of apparel resulting from motion of at least part of a wearer of the article of apparel, and the controller operable to control activation of the light source in response to motion of the article of apparel sensed by the sensor (column 2, lines 9 to 12).

5. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mott (prior art cited by applicant).

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Mott shows an article of apparel (810) carrying an enclosed chamber (844), a light source comprising at least one light emitting diode (826) operable to illuminate the chamber with light, the chamber having a light affecting device (842) adapted to affect light from the light source so as to produce a light pattern (figure 22), the chamber having a light transmissive portion providing a window (opening of the chamber) through which light from the light source can be transmitted to enable the light pattern to be viewed, the article also carrying a controller having a sensor (818) operable to sense motion of the article of apparel resulting from motion of at least part of a wearer of the article of apparel, and the controller operable to control activation of the light source in response to motion of the article of apparel sensed by the sensor (figure 17A).

6. Claims 58, 61, 62 and 64 to 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Mott (prior art cited by applicant).

Mott shows an article of footwear (810) carrying an enclosed chamber (844) having a light transmissive portion (opening of the chamber), a light source comprising at least one light emitting diode (826) operable to direct light through the light transmissive portion, a light affecting device (842) mounted in the chamber to cause light from the light source to produce a light pattern having a predetermined shape (figure 22) having an image (column 20, line 57) on the ground near or adjacent a wearer of the item of footwear, a battery operated control circuit having a sensor such as a piezoelectric switch (818) responsive to footfalls of the wearer of the item of footwear to cause the control circuit to control the activation of the light source in response to footfalls of the wearer of the item of footwear, the item of footwear having a sole portion (812) with an upper portion, and the chamber mounted to the upper portion of the item of footwear.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 9 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rapisarda in view of Perry et al. (prior art previously cited).

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Rapisarda discloses an article of apparel (10) carrying an enclosed chamber (a hollow cavity, column 1, line 56), a light source comprising at least one light emitting diode (14) operable to illuminate the chamber with light, the chamber having a light transmissive portion providing a window (13) through which light from the light source can be transmitted to enable the light to be viewed, the article also carrying a controller having a sensor (17) operable to sense motion of the article of apparel resulting from motion of a wearer of the article of apparel, and the controller operable to control activation of the light source in response to motion of the article of apparel sensed by the sensor (column 2, lines 9 to 12). However, Rapisarda does not disclose a light affecting device, which is movable, adapted to affect light from the light source so as to produce a light pattern, and the light affecting device having light affecting elements mounted within the chamber so as to move in response to movement of the wearer.

Perry et al. teach an article of apparel (82) carrying a chamber having a light affecting device having light affecting elements (52, column 5, lines 29 to 30, column 6, lines 51 to 55 and 62 to 64), which is movable, adapted to affect light from the light source (LED) to produce a light pattern (figure 8, column 3, lines 15 to 17, column 7, lines 35 to 36 and ..), and the light affecting elements mounted within the chamber so as to move in response to movement of a wearer (column 7, lines 38 to 39) of the article.

It would have been obvious to one skilled in the art to provide the chamber of Rapisarda with light affecting elements which is movable and adapted to affect light from the light source in response to movement of a wearer, as shown by Perry et al., to produce a light pattern in view of both references are directed to article of apparel such as a shoe.

9. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (prior art cited by applicant).

Mott discloses the invention substantially as claimed with the exception of disclosing the material of the enclosed chamber.

Note that to have the enclosed chamber a plastic enclosure would have been an obvious matter of preference, which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within a purview of an ordinary engineering design technique to have

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the enclosed chamber in any suitable material including plastic for light weight and durable to suit different applications.

10. Claims 3, 7, 10 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 59 and 63 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 67 to 69 are allowed.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is 571-272-2815.

Y. Q.
June 21, 2005



Y Quach Lee
Patent Examiner
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